

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN HENDRICKSON

Appeal No. 97-3661
Application No. 08/456,692¹

ON BRIEF

Before ABRAMS, FRANKFORT and STAAB, *Administrative Patent Judges*.
ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 23-44, which constitute all of the claims remaining of record in the application.

¹ Application for patent filed June 1, 1995. According to appellant, this application is a continuation-in-part of Application 29/016,831 filed December 27, 1993, now U.S. Patent No. D363,943 issued November 7, 1995.

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The appellant's invention is directed to a funnel (claims 23-27), a process for making a funnel (claims 28-32), a funnel made by a particular process (claims 33-37), the combination of separated walls defining a space and a funnel for directing material into the space (claims 38-41), and the combination of a form and a funnel for directing material into the form (claims 42-44). The subject matter before us on appeal is illustrated by reference to claim 23, which has been reproduced in an appendix to the Appeal Brief (Paper No. 10).

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Hepburn	418,719	Jan. 7, 1890
Belden	657,080	Sep. 4, 1900
Melvin	2,827,931	Mar. 25, 1958
Joseph	2,940,298	Jun. 14, 1960

THE REJECTIONS

Claims 23-25, 38, 39 and 42-44 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Melvin.

Claims 28-30 and 33-35 stand rejected under 35 U.S.C. § 103 as being unpatentable over Melvin.

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Claims 26, 27, 31, 32, 36, 37, 40 and 41 stand rejected under 35 U.S.C. § 103 as being unpatentable over Melvin in view of Belden, Hepburn and Joseph.

The rejections are explained in the Examiner's Answer.

The opposing viewpoints of the appellant are set forth in the Brief and the Reply Brief.

OPINION

The Examiner's Rejection Under 35 U.S.C. § 102(b)

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of the claimed invention. See *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), *cert. dismissed sub nom.*, *Hazeltine Corp. v. RCA Corp.*, 468 U.S. 1228 (1984).

We find that all of the various walls, openings, sides and ends which form the funnel recited in independent claims 23, 38 and 42 are disclosed in Melvin, in the relationship required in these claims. We also find that the separated walls required by claim 38, and the form of claim 42, are found in Melvin. However, contrary to the position taken by the examiner, we agree with the appellant that Melvin does not explicitly teach that the

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funnel be of a "unitary one-piece continuous construction," as also is required by these three independent claims. This being the case, Melvin does not anticipate these claims, and the rejection under Section 102(b) cannot be sustained. It then follows that the like rejection of dependent claims 24, 25, 39, 43 and 44 cannot be sustained.

Additionally, we do not agree with the examiner that the "recess" recited in claims 25 and 44 is present in Melvin, and for this reason also claims 25 and 44 are not anticipated by Melvin.

New Rejection By The Board Under 35 U.S.C. § 103

Pursuant to our authority under 37 C.F.R. § 196(b), this panel of the Board enters the following new rejection:

Claims 23, 24, 38, 39, 42 and 43 are rejected under 35 U.S.C. § 103 as being unpatentable over Melvin.

The question under 35 U.S.C. § 103 is not merely what the references expressly teach but what they would have suggested to one of ordinary skill in the art at the time the invention was made. See *Merck & Co., Inc. v. Biocraft Laboratories, Inc.*, 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989) and *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). While

there must be some suggestion or motivation for one of ordinary skill in the art to combine the teachings of the references, it is not necessary that such be found within the four corners of the references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Further, in an obviousness assessment, skill is presumed on the part of the artisan, rather than the lack thereof. *In re Sovish*, 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985). Insofar as the references themselves are concerned, we are bound to consider the disclosure of each for what it fairly teaches one of ordinary skill in the art, including not only the specific teachings, but also the inferences which one of ordinary skill in the art would reasonably have been expected to draw therefrom. See *In re Boe*, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966); and *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

As we stated above in our discussion of the Section 102 rejection of these claims, all of the elements of the funnel recited in the claims are disclosed by Melvin in the relationship set forth in the claims, and Melvin also discloses the separated

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walls of claim 38 and the form of claim 42. As far as the limitation that the funnel be of a "unitary one-piece continuous construction" is concerned, we agree that it is not explicitly found in Melvin. Melvin does suggest, however, that the funnel be made of plastic (column 2, line 62), and that mouth and the spout be "integral" (column 2, lines 49-50). It is our opinion that one of ordinary skill in the art would have found it obvious to make the Melvin funnel of unitary one-piece continuous construction for the self-evident advantages thereof, which would have been known to the artisan working in this field, such as ease of molding, strength and smoothness. Suggestion is found in the common knowledge and common sense that should be accorded to one of ordinary skill in the art. *In re Bozek, supra*.

As for claims 24, 29, 34, 39 and 43, we first point out that during examination before the Patent and Trademark Office, the pending claims in an application must be interpreted as broadly as their terms reasonably allow, without reading any limitations from the specification into the claims (see *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)), for if the limitations in the specification were required to be read into the claims there would be no need for claims and no basis for the requirement of 35 U.S.C. § 112 that the specification conclude

with claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention (see *Sjolund v. Musland*, 847 F.2d 1573, 1580, 6 USPQ2d 2020, 2027 (Fed. Cir. 1988)). These claims add to their respective parent claims the additional step of "a rim on the outer part of" the sloping sides and ends of the funnel. The common definition of "rim" is the outer edge or border of something.² The outer edge of the Melvin funnel therefore constitutes a "rim," and thus the terms of these claims also are met.

The Examiner's Rejections Under 35 U.S.C. § 103

The first Section 103 rejection advanced by the examiner is that claims 28-30 and 33-35 would have been obvious in view of Melvin. Independent claim 28 is directed to a process for making a funnel, and independent claim 33 to a funnel made by a particular process. We begin our analysis by reiterating our finding that all of the elements of the funnel recited in these claims are disclosed in Melvin, and in the required relationship to one another. We share the examiner's view that it would have been obvious to one of ordinary skill in the art to construct the funnel in the manner set forth in claims 28 and 33, a conclusion

² See, for example, Merriam Webster's Collegiate Dictionary, Tenth Edition, 1996, page 1009.

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which the appellant does not dispute, except for the step of forming it to be of a "unitary one-piece continuous construction." With regard to this, as we expressed above in the new rejection we entered, it is our opinion that one of ordinary skill in the art would have found it obvious to make the claimed funnel in such a fashion for the self-evident advantages thereof, based upon the common knowledge and common sense that should be accorded to one of ordinary skill in the art.

As we did above, we conclude that the teachings of Melvin, considered in the light of the knowledge which must be accorded to one of ordinary skill in the art, establish a *prima facie* case of obviousness with regard to the subject matter of independent claims 28 and 33, and we will sustain the rejection of these two claims.

Claims 29 and 34 add to their respective parent claims the additional step of "forming a rim on the outer part of" the sloping sides and ends. Again referring to our new rejection, the outer edge of the Melvin funnel constitutes a "rim," and therefore we shall sustain the rejection of claims 29 and 34.

We reach the opposite conclusion with regard to claims 30 and 35, which add a "recess." As was the case above with regard to the Section 102 rejection, this feature is not taught by

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Melvin, and we therefore will not sustain the rejection of these claims.

The second Section 103 rejection made by the examiner is that claims 26, 27, 31, 32, 36, 37, 40 and 41 are unpatentable over the teachings of Melvin in view of Belden, Hepburn and Joseph. Claims 26, 31, 36 and 40 add the limitation that the rim in the claims from which they depend is "directed outwardly" from the sloping sides and ends of the funnel. All three of the secondary references here applied disclose rims extending outwardly from the sloping sides of funnels. We agree with the examiner that extending the rim of the Melvin funnel outwardly from the sloping sides would have been an obvious expedient to one of ordinary skill in the art for the self-evident advantages thereof, such as structural rigidity, which would have been known to the artisan. The rejection of these claims therefore is sustained.

Claims 27, 32, 37 and 41 add the "recess" discussed above, which in our view is not taught by Melvin. Nor do we find this to be rendered obvious by Belden, Hepburn or Joseph. We therefore will not sustain the rejection of these claims.

We have carefully considered the arguments presented by the appellant as they apply to the examiner's rejections and to the

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new rejection which we have entered. However, as to those rejections we have sustained, as well as the new one, we have not found these arguments to be persuasive. Our position with regard to them should be apparent from the foregoing discussions.

SUMMARY

The examiner's rejection of claims 23-25, 38, 39 and 42-44 as being anticipated by Melvin is not sustained.

The examiner's rejection of claims 28, 29, 33 and 34 as being unpatentable over Melvin is sustained.

The examiner's rejection of claims 30 and 35 as being unpatentable over Melvin is not sustained.

The examiner's rejection of claims 26, 31, 36 and 40 as being unpatentable over Melvin in view of Belden, Hepburn and Joseph is sustained.

The examiner's rejection of claims 27, 32, 37 and 41 as being unpatentable over Melvin in view of Belden, Hepburn and Joseph is not sustained.

Pursuant to 37 C.F.R. § 196(b), claims 23, 24, 38, 39, 42 and 43 are rejected under 35 U.S.C. § 103 as being unpatentable over Melvin.

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No rejections stand against claims 25, 27, 30, 32, 35, 37, 41 and 44.

The decision of the examiner is affirmed-in-part.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63,122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

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(2) Request that the application be reheard under
§ 1.197(b) by the Board of Patent Appeals and
Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the
Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to
preserve the right to seek review under 35 U.S.C. §§ 141 or 145
with respect to the affirmed rejection, the effective date of the
affirmance is deferred until conclusion of the prosecution before
the examiner unless, as a mere incident to the limited
prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and
this does not result in allowance of the application, abandonment
or a second appeal, this case should be returned to the Board of
Patent Appeals and Interferences for final action on the affirmed
rejection, including any timely request for rehearing thereof.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART, 1.196(b)

NEAL E. ABRAMS)	
Administrative Patent Judge))	
)	
)	
CHARLES E. FRANKFORT)	BOARD OF PATENT
Administrative Patent Judge))	APPEALS AND
)	INTERFERENCES
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